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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 2870-0171P													
	Application Number 09/928,339-Conf. #6675	Filed August 14, 2001													
	First Named Inventor Tokuju OIKAWA														
	Art Unit 1752	Examiner T. Chea													
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table><tr><td><input type="checkbox"/></td><td>applicant /inventor.</td><td rowspan="3"> Signature</td></tr><tr><td><input type="checkbox"/></td><td>assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>Marc S. Weiner Typed or printed name</td></tr><tr><td><input type="checkbox"/></td><td>attorney or agent of record. Registration number _____</td><td>(703) 205-8000 Telephone number</td></tr><tr><td><input checked="" type="checkbox"/></td><td>attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. 32,181</td><td>November 3, 2005 Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</p>				<input type="checkbox"/>	applicant /inventor.	 Signature	<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Marc S. Weiner Typed or printed name	<input type="checkbox"/>	attorney or agent of record. Registration number _____	(703) 205-8000 Telephone number	<input checked="" type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. 32,181	November 3, 2005 Date
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PATENT  
2870-0171P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: OIKAWA, Tokuju Conf.: 6675  
Appl. No.: 09/928,339 Group: 1752  
Filed: August 14, 2001 Examiner: T. Chea  
For: PHOTOTHERMOGRAPHIC MATERIAL

**ARGUMENTS IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Applicant respectfully requests reconsideration of the Final Rejection dated May 3, 2005 concerning claims 1-21 of the present application. Two issues remain:

1. The Examiner has rejected claims 1-16 and 18-20 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being obvious over JP 2000-112072 (JP '072).

2. The Examiner has also rejected claim 17 under 35 U.S.C. §103(a) as being obvious over JP '072 in view of Ito et al, EP 1096310 (Ito '310).

None of the references cited by the Examiner (JP '072 and Ito '310) suggest or disclose the subject matter of the present claims. The present claims relate to a photothermographic material which must satisfy at least one of Condition I and Condition II.

Condition I includes the limitation that: the  $\text{NH}_4^+$  content in all the layers formed on the image-forming layer side of the support is 0.06 mmol/m<sup>2</sup> or less.

Condition II includes the limitation that: the film surface pH of the image-forming layer side of the support is substantially unchanged after coating, and the layers formed on the image-forming layer side of the support do not substantially contain ammonia.

However, neither Condition I nor Condition II is satisfied, either expressly or inherently by the cited art. Attention is directed to the previously submitted Declarations including:

- (1) the Nakano Declaration submitted on November 22, 2002,
- (2) the Oikawa Declaration submitted on November 7, 2003, and
- (3) the Oikawa Declaration submitted on May 11, 2004.

The Declarative Evidence reveals the lack of inherency of the present subject matter in the cited references. Without such inherent disclosure there can be no anticipation. Further, absent inherent disclosure, the lack of any motivation, such as might be provided by explicit disclosure, to arrive at Condition I or Condition II, prevents a proper *prima facie* case of obviousness from being asserted. Specific arguments are summarized below:

The cited art fails to suggest or disclose, either explicitly or inherently, Condition I or Condition II

The primary reference cited is JP '072. In the November 7, 2003 Oikawa Declaration, three samples (Samples 1, 2, and 3) were tested. Sample 3 was prepared according to Sample 3 shown in Table 1 of JP '072.

A review of the results for Sample 3 reveal that the amounts of ammonium ion in all the layers formed on the image forming side are outside of the claimed ranges. Sample 3 contained 0.23 mmol/m<sup>2</sup> of ammonium ion in all the layers formed on the image forming layer side. However, Condition I of the present claims requires that the amount of ammonium ion in all the layers formed on the image-forming layer side of the support be 0.06 mmol/m<sup>2</sup> or less. Condition II of the claims requires that the layers formed on the image-forming layer side of the support do not substantially contain ammonia. Thus, neither of these conditions is achieved by the cited art.

The Examiner has asserted that Samples Nos. 12-14 described in Table 1 in paragraph [0285] of JP '072 were prepared by using NaOH as a pH buffer and their surface pH values were set to 5.2, 6.2 or 6.5. While this may be true, these conditions do not affect NH<sub>4</sub><sup>+</sup> content requirements of

Conditions I or II of the present claims. That is, regardless of the modification of the layer surface pH of the samples, the  $\text{NH}_4^+$  content is unaffected. Once the  $\text{NH}_4^+$  content has been set by the LACSTAR 3370B binder, the use of acids (such as NaOH) or pH buffers may provide different counter anions, but do not alter the actual  $\text{NH}_4^+$  content in the samples.

Each of Samples 12-14 of JP '072 were prepared using LACSTAR 3370B as a binder. LACSTAR 3370B contains a considerable amount of  $\text{NH}_4^+$  as was demonstrated in the Nakano Declaration submitted on November 22, 2002. Accordingly, regardless of the type of pH modifier used or the value of the layer surface pH, as long as LACSTAR 3370B is used as a binder, the  $\text{NH}_4^+$  content in all of the layers formed on the image-forming sides of Samples 12-14 will be determined based upon the  $\text{NH}_4^+$  content of LACSTAR 3370B.

Further, it was demonstrated in the Oikawa Declaration submitted on November 7, 2003 that the  $\text{NH}_4^+$  content in all of the layers formed on the image-forming sides of the samples, which were prepared using LACSTAR 3370B as a binder, was almost  $0.25 \text{ mmol/m}^2$ . It is therefore evident that the samples described in JP '072 contain  $\text{NH}_4^+$  in an amount much larger than  $0.06 \text{ mmol/m}^2$  as required by Condition I. Such amounts also are greater than layers that do "not substantially contain ammonia" as required by Condition II.

The  $\text{NH}_4^+$  content is not decided by the layer surface pH. The layer surface pH of a sample is varied depending upon types of acids or bases contained in the sample. If the layer surface pH of a sample prepared according to JP '072 (using LACSTAR 3370B as a binder) is adjusted to 5.2, 6.2 or 6.5, the  $\text{NH}_4^+$  content is not changed. The counter anions for  $\text{NH}_4^+$  may change, but the  $\text{NH}_4^+$  molecules cannot be physically removed from the sample.

The fact that the  $\text{NH}_4^+$  content is a sample prepared using LACSTAR 3370B as a binder is almost  $0.25 \text{ mmol/m}^2$  was also shown in the Oikawa Declaration submitted on May 11, 2004. Sample Nos. 7-9, 12-14 and 17-19 of Example 1 of U.S. 6,100,022 were prepared using NaOH or

phosphoric acid as a pH buffer and their surface pH values were set to 4.9, 5.5 or 6.2. However, since they were prepared using LACSTAR 3370B as a binder, as proven in the latest Declaration, the  $\text{NH}_4^+$  contents of the samples were almost  $0.25 \text{ mmol/m}^2$ .

Accordingly, it is evident that Sample Nos. 12-14 described in Table 1 at paragraph [0285] of JP '072 contain  $\text{NH}_4^+$  is an amount of almost  $0.25 \text{ mmol/m}^2$ , which is greater than the amounts required by the claims. Additionally, in the Oikawa Declaration submitted on May 11, 2004 it was demonstrated that samples whose  $\text{NH}_4^+$  content were almost  $0.25 \text{ mmol/m}^2$  could not reduce the different in the line widths in the same manner as a composition falling with the scope of independent claim 1.

Accordingly, the cited references of JP '072 and Ito '310 fail to achieve the presently claimed subject matter. The references also lack any explicit disclosure of Condition I or Condition II, thus no anticipation exists. Additionally, there also exists no *prima facie* case of obviousness. Specifically, there exists no motivation in any of the references including the secondary reference of Ito '310 to achieve the presently claimed subject matter. Thus, the Examiner has failed to present a valid *prima facie* case of obviousness.

However, even if the Examiner has hypothetically established a *prima facie* case of obviousness, Applicant submits that the presently claimed subject matter achieves unexpectedly superior results compared to the cited art. For instance, in the latest Oikawa Declaration submitted on May 11, 2004 it was demonstrated that samples whose  $\text{NH}_4^+$  contents were almost  $0.25 \text{ mmol/m}^2$  could not reduce the different in the line widths in the same manner as a composition falling with the scope of independent claim 1.

Also, as shown in the Table 1 of the present specification, the claimed invention shows much lower temperature and humidity dependency than samples No. 1-3 and No. 1-8. Applicant submits


that one skilled in the art could not have expected that such excellent effects could be obtained by satisfying Condition I of the claimed invention.

Further, as shown in Table II of the present specification, the claimed invention shows much lower temperature and humidity dependency than comparative samples that do not satisfy Condition II. Applicant submits that one skilled in the art could not have expected that such excellent effects could be obtained by satisfying Condition II of claimed invention.

Accordingly, Applicant respectfully submits that the Examiner has failed to present a valid case of anticipation or a valid *prima facie* case of obviousness. Further, even if the Examiner has hypothetically presented a *prima facie* case of obviousness, the unexpected results according to the present invention with respect to temperature and humidity dependency, rebut any hypothetical *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

Respectfully submitted,

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